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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,469	01/02/2002	Jennifer Bryman	05793.3054-00	5583
22852	7590	11/01/2007		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER CHAMPAGNE, DONALD	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 11/01/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/032,469

**Applicant(s)**

BRYMAN ET AL.

**Examiner**

Donald L. Champagne

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102 and 35 USC § 103***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-9, 12-16 and 18-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Schulze, Jr. (US005483049A).
4. Schulze, Jr. teaches (independent claims 1, 13, 18 and 22) a method and system for issuing/providing exchange *coupons 40* and redemption *checks 48*, either of which reads on "partnership checks"<sup>1</sup>, the method comprising:

analyzing a group of merchants based on a set of merchant qualification criteria (e.g., in a particular geographic region,) to identify a merchant for associating with an *exchange coupon 40*/partnership check (col. 18 lines 34-39);

creating the *exchange coupon 40*/partnership check such that the *exchange coupon 40*/partnership check is redeemable with the identified merchant (col. 2 line 65 to col. 3 line 4 and col. 3 line 60 to col. 4 line 5); and

sending the created *exchange coupon 40*/partnership check to a customer (col. 18 lines 14-19).

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<sup>1</sup> From the definitions of a "partnership check" and a "value sharing relationship" in para. [0026] of the published application (US 20030126011A1).

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For claim 13, forming a "value sharing relationship" with at least one *retailer* (merchant) is taught at col. 1 line 62 to col. 2 line 24). For claim 18, "generating a list of prospective merchants" is inherent ; "generating/analyzing a list of prospective customers" is taught at col. 6 lines 58-67 and col. 3 line 1).

5. Schulze, Jr. also teaches at the citations given above claims 2, 5, 9, 12, 20 and 25.
6. Schulze, Jr. also teaches claims 3, 4, 23 and 24 (col. 18 lines 19-24 and 34-39); claim 6-8, 14-16, 21 and 26 (col. 2 lines 4-52); and claim 19 (*database 228*, col. 9 line 26-29).
7. Claims 10, 11 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schulze, Jr. (US005483049A). Schulze, Jr. does not teach inserts (claims 10 and 17) with the mailed coupon/check and an incentive chosen so as to maximize profit (claim 11). Official notice is taken (MPEP § 2144.03) that both of these limitations were in common use, and therefore obvious to one of ordinary skill in the art, at the time of the instant invention.
8. Traverse of the taking of Official Notice - Applicant has traversed the examiner's taking of official notice (pp. 15-18 of the arguments filed on 9 April 2007). However, applicant has not provided adequate information or argument so that *on its face* it creates a reasonable doubt regarding the circumstances justifying the official notice (MPEP § 2144.03). An effective traverse must be based on alleged evidence, not mere denial. Applicant could, for example, have gotten testimony from an economics professor saying that it is not notoriously common to try to maximize profit. Or applicant could have offered testimony from a mailing firm testifying that it is not notoriously common for checks to be sent with informational inserts. The examiner would then have been compelled to produce counter evidence in order to maintain the tasking of official notice. But applicant submitted no such evidence. Therefore, the presentation of a reference to substantiate the official notice is not deemed necessary. The examiner's taking of official notice is maintained.

### ***Response to Arguments***

9. Applicant's arguments filed with an amendment on 9 April 2007 have been fully considered but they are not persuasive.
10. Applicant argues (p. 11, beginning of 2<sup>nd</sup> para.) that col. 2, lines 65-67, does not teach "analyzing a group of merchants ... to identify a merchant for associating with a partnership

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check". Applicant has not read the entire citation. The subject limitation is taught at col. 18 lines 34-39. Col. 2, lines 65-67 was intended to describe the merchant identified, but has now been dropped as confusing.

11. Applicant argues (p. 11, 3<sup>rd</sup> para.) that col. 18 lines 34-39 does not teach the subject limitation. The examiner does not know how to better explain what seems to be plain language. If the applicant is convinced that the examiner is wrong, applicant should appeal to the Board. Applicant repeats this argument for claims 22, 2-9 and 23-26 at the bottom of p. 12.
12. Applicant argues (p. 13, top) that "a value sharing relationship" is not taught at col. 1 lines 65-67. The citation was to col. 1 line 62 to col. 2 line 4 (now line 24), not just the three cited lines.
13. Applicant argues (p. 14, bottom) that no support has been provided as to why "generating a list of prospective merchants" is inherent. The inherency follows from the teaching (col. 2 lines 1-2) that the reference invention *redeems coupons presented to the retailers*. Said *retailers* read on "prospective merchants", and their coupons could not be redeemed if they were not known, which reads on listed.
14. Applicant argues (pp. 15-18) that the taking of official notice is unjustified in part because the three subject claims are "complex", and that every limitation was not addressed. The examiner does not agree. Claims 10 and 17 are materially the same and claim 11 only adds the limitation of a common economic principle.

### **Conclusion**

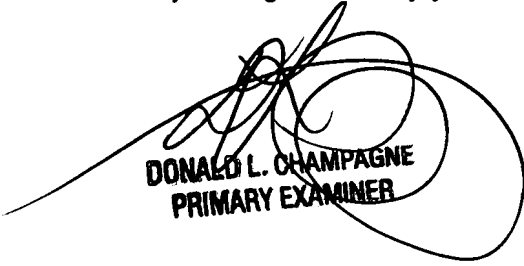
15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
16. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 9:30 AM to 8 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717. The fax phone number for all *formal* matters is 571-273-8300.
18. The examiner's supervisor, Eric Stamber, can be reached on 571-272-6724.
19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
20. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, [www.uspto.gov](http://www.uspto.gov). At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

20 October 2007

  
DONALD L. CHAMPAGNE  
PRIMARY EXAMINER

Donald L. Champagne  
Primary Examiner  
Art Unit 3622